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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,468	11/09/2001	Ranjith Divigalpitiya	55525US011	5982

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EXAMINER	
LE, HOA T	

ART UNIT	PAPER NUMBER
1773	

DATE MAILED: 04/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	**Application No.** 10/008,468	**Applicant(s)** RANJITH ET AL	
	Examiner H. T. Le	**Art Unit** 1773	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 March 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: *None*.
   Claim(s) objected to: *None*.
   Claim(s) rejected: *32-39*.
   Claim(s) withdrawn from consideration: *None*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See attachment (Detailed Advisory Action).
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____.

H. T. Le
Primary Examiner
Art Unit: 1773

DETAILED ADVISORY ACTION

1. Claims 32-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement as set forth in the last office action and further discussed below.

2. Applicants argued that "[a]lthough the disclosure may not explicitly use the phrase "non-magnetic particles... the explicit statement that "any" particle can be used, as well as the numerous examples of non-magnetic particles reasonably convey to one skilled in the relevant art that the invention had possession of the claimed subject matter." A mere statement that "any" particle would do does not provide support for specific "non-magnetic" particles. In addition, although some particles listed as examples in the specification happen to be non-magnetic material, it does not provide support for a broad class of non-magnetic particles. In In re Barker 194 USPQ 471, 474 quoting In re Winkhaus 188 USPQ at 131, the court held that "... that a person skilled in the art might realize from reading the disclosure that such a step is *possible* is not a sufficient indication to that person that that step is part of appellants' invention". In this case, though a person skilled in the art might recognize some of the particles given as examples in the instant specification are particles of non-magnetic material, it is not a sufficient indication to one skill in the art that non-magnetic particles are part of Applicants' invention.

3. To support their arguments, Applicants cited "*Lampi Corp. v American Power Products. Inc.*". According to Applicants, in this case, the Court noted that although the specification

twice referred to "identical" half-shells, the specification also included references to half-shells without the modifier "identical" indicating that identical half-shells are not critical to the invention; therefore, literally describing identical half-shells along with other types of shells supported claims to both identical and non-identical half-shells.

First of all, a patent enjoys the presumption of validity; therefore, if there are two possible ways of looking at one issue, the Court would usually choose the one that validates a patent. The present application, however, is not entitled to the presumption of validity that only adheres to a patent. In Ex parte Raible 8 USPQ2d 1709, 1710 (BPAI 1988), the court held that: "The function of the description requirement is to ensure that the applicant had possession, as of the filing date of his application, of the specific subject matter later claimed by him." And in In re Wertheim 191 USPQ 90, 97 (CCPA 1976), the court opined, "We must decide whether the invention appellants seek to protect by their claims is part of the invention that appellants have described *as theirs* in the specification." (emphasis in the original). Thus the key question is whether at the time the application was filed, Applicants have envisioned non-magnetic particles as part of Applicants' invention. The answer here is no.

Secondly, "magnetic" and "non-magnetic" are not "modifier" as in the case of "identical" and "non-identical". "Magnetic" and "non-magnetic" signify differences in chemical reactivity, chemical structure and physical property. The "critical" difference between magnetic and non-magnetic particles is evident in Applicants' own arguments in the

response filed May 19, 2005. There applicants argued that non-magnetic particles cannot be used in the particle-embedded web taught by the Jin Patent (US 4,737,112) because the Jin patent relied on "repulsion between magnetic particles, which is generated by a uniform magnetic field, to prevent unintended contact between pairs of particles" (citing Jin patent, col. 2, line 64 - col. 3. line 5, and claim 1).

4. Applicant's arguments filed March 22, 2005 have been fully considered but they are not persuasive for the reasons set forth above.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to H. T. Le whose telephone number is 571-272-1511. The examiner can normally be reached on 10:00 a.m. to 6:30 p.m., Mondays to Fridays.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

H. T. Le
Primary Examiner
Art Unit 1773